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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,957	02/16/2001	Larry L. Stein	101049.90010	5776
26710	7590	05/05/2005	EXAMINER THAI, CANG G	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/785,957	<b>Applicant(s)</b> STEIN ET AL.	
	<b>Examiner</b> Cang G. Thai	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 1/10/2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7, recites the limitations of the phases "estimating cost of a building" (Line 1) and "input device and building element" in step (c) are not clearly expressed. Is the estimating cost of a damaged building is the total cost of a damaged building that would include regular elements? It is also not clear on the total cost, if there is no summing step to calculate the total cost. It is not clear if the building elements is referring to materials or damaged elements? It is also unclear on the input device for retrieval of related information.

### ***Response to Arguments***

In response to applicants' argument that "building element" term is interpreted as a damaged or undamaged element in a damaged building. Building element would also be interpreted as a new material (regular material) in order to perform the estimating cost of a damaged building.

The summing step must be added into the body of the claim to calculate the total cost of a damaged building for clarification.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,542,933 (DURST, JR. ET AL.) in view of U.S. Patent No. 6,810,401 (THOMPSON ET AL.).

As for Claim 1, DURST discloses a system comprising:

- h) a medium displaying a plurality of indicia {See Column 5, Lines 36-37, wherein this reads over "the client computer may also be a web-enabled cell phone, PDA, etc."},
- i) a data input device {See Column 5, Lines 39-42, wherein this reads over "the client computer also includes data entry devices such as a keyboard, a bar code scanning wand, and a mouse for entry of the linkage codes as desired"}}, and
- j) a portable computer connected to the data input device and comprising a storage device, a processor and output device, the portable computer responding to the signal from the data input device by storing in the storage device {See Column 5, Lines 39-42, wherein this reads over "the client computer also includes data entry

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devices such as a keyboard, a bar code scanning wand, and a mouse for entry of the linkage codes as desired”}.

DURST discloses only the system for assessing network data comprising the steps of (h)-(j).

THOMPSON discloses the plurality of building elements {See Fig. 7, Fig. 7C, wherein this reads over the description of building element “White with clear IG tempered Insulated Glass”}. It would have been obvious to combine the accessing networked data, as taught by DURST, with the system to configure and estimate the cost of a desired product, component, or project (Column 3, Lines 38-40), as taught by THOMPSON because it would satisfy the engineering criteria of a given project and assemble prices from a variety of data sources (Column 1, Lines 14-16).

As for Claim 2, DURST further discloses:

- k) storage device contains a data table {See Column 12, Lines 41-42, wherein this reads over “the registration server stores the information”}.
- l) the processor is responding to the signal from the data input device by obtaining the cost of the given building element and utilizing that cost to determine a total cost of construction building {See Column 5, Lines 39-42, wherein this reads over “the client computer also includes data entry devices such as a keyboard, a bar code scanning wand, and a mouse for entry of the linkage codes as desired”}, and
- m) the output device producing an output signal {See Column 6, Lines 44-47, wherein this reads over “the software for the system makes the record of each

"hit", recording the date, time, item accessed and a user ID indicating who made the access, in a hit log database"}.

DURST discloses only the steps of (k)-(m).

THOMPSON discloses the building elements {See Fig. 7, Fig. 7C}. It would have been obvious to combine DURST teaching with the system to configure and estimate the cost of a desired product, component, or project (Column 3, Lines 38-40), as taught by THOMPSON because it would satisfy the engineering criteria of a given project and assemble price from a variety of data sources (Column 1, Lines 14-16).

As for Claim 3, DURST discloses wherein each of the plurality of indicia encodes a number, and the portable computer uses a number received from the data input device to select a cost contained in the data table {See Column 8, Lines 31-34, wherein this reads over "the bar code is preferably in the "Code 128" zymology, and contains the same data as does digit string printed below the bar code, except that the embedded dashes are omitted"}.

THOMPSON discloses the data table {Column 11, Lines 63-64, wherein this reads over "the DataGrid is a tool that allows the user to view a table of answers"}. It would have been obvious to combine the DURST teaching with the DataGrid as a tool that allows the user to view a table of answers (Column 11, Lines 63-64), as taught by THOMPSON because it would satisfy the engineering criteria of a given project and assemble price from a variety of data sources (Column 1, Lines 14-16).

As for Claim 4, DURST discloses wherein the data input device comprises a barcode reader, and the plurality of indicia are barcodes {See Column 9, Lines 30-31,

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wherein this reads over “a particular manufacturer may “own” multiple Manufacturer Numbers, whether by design or by acquisition”}.

As for Claim 5, DURST discloses wherein each of the barcodes encodes a numerical value, and the portable computer uses a numerical value received from the barcode reader to select an entry in the data table {See Column 9, Lines 30-31, wherein this reads over “a particular manufacturer may “own” multiple Manufacturer Numbers, whether by design or by acquisition”}.

THOMPSON discloses a numerical value to select an entry in the data table {See Column 3, Lines 42-46, wherein this reads over “the interactive nature of the system aides the user in arriving at the desired product, component, or project selection and the production of any corresponding information (e.g. layouts, pricing, schematics, specifications, etc.)”}. It would have been obvious to combine DURST teaching with the DataGrid as a tool that allows the user to view a table of answers (Column 11, Lines 63-64), as taught by THOMPSON because it would satisfy the engineering criteria of a given project and assemble price from a variety of data sources (Column 1, Lines 14-16).

As for Claim 6, DURST discloses wherein the signal from the data input device designates a given command, and the processor responds to the signal by executing the given command {See Column 6, Lines 44-47, wherein this reads over “the software for the system makes the record of each “hit”, recording the date, time, item accessed and a user ID indicating who made the access, in a hit log database”}.

### ***Response to Arguments***

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3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Claims 1-6, combining the teaching of DURST ET AL. and THOMPSON ET AL. would teach a computer system for construction job estimation, it still does teach a medium for displaying a plurality of indicia representing different building elements and a data input device (keyboard) for selecting one of those plurality of indicia (icon).

5. Claims 7-19 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,542,933 (DURST, JR. ET AL.) in view of U.S. Patent No. 6,810,401 (THOMPSON ET AL.), and further in view of U.S. Patent No. 5,950,169 (BORGHESI ET AL.).

As for Claim 7, DURST discloses a method comprising:

- a) providing, a portable computer having a storage device that stores a data table {See Column 5, Lines 36-37, wherein this reads over "the client computer may also be a web-enabled cell phone, PDA, etc."},



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- b) identifying a given building element that is damaged {See Column 5, Lines 36-37, wherein this reads over "the client computer may also be a web-enabled cell phone, PDA, etc."},
- c) at the building, utilizing the input device to designate the given building element and producing a signal indicating the given building element {See Column 5, Lines 39-42, wherein this reads over "the client computer also includes data entry devices such as a keyboard, a bar code scanning wand, and a mouse for entry of the linkage codes as desired"}},
- d) the portable computer utilizing the signal to access the data table and obtain the cost of the given building element {See Column 6, Lines 44-47, wherein this reads over "the software for the system makes the record of each "hit", recording the date, time, item accessed and a user ID indicating who made the access, in a hit log database"}},
- e) the portable computer employing the cost of the given building element to calculate a total cost to the building {See Column 14, Lines 33-38, wherein this reads over "statistics may be compiled to facilitate the cost allocations to the various clients of the system where the attributes for the detailed levels of routing utilized for that transaction request are recorded or monitored and compared to a pricing structure stored in the information server and"}},
- f) repeating steps (b) through (e) for other building elements {See Column 7, Lines 31-33, wherein this reads over "display the resulting content that is of interest to the user that is returned from one or more computing devices"}}, and

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- g) producing an output signal from the output device that indicates the total cost to the building {See Column 5, Lines 39-42, wherein this reads over “the client computer also includes data entry devices such as a keyboard, a bar code scanning wand, and a mouse for entry of the linkage codes as desired”}.

DURST discloses only the method of a building comprising the steps of (a)-(g).

THOMPSON discloses the estimating cost with the plurality of building elements {See Column 3, Lines 38-40, wherein this reads over “the configuration system interacts with the system to configure and estimate the cost of a desired product, component, or project”}.

BORGHESI discloses the method of damage estimate {See Column 5, Lines 4-5, wherein this reads over “inspection is conducted to determine the extent of damage”}. It would have been obvious to combine the DURST and THOMPSON teachings with the damage estimate (Element 16), as taught by BORGHESI because it would eliminate the need for separate paper files or data files and eliminate the need for the wasteful reentry of existing files (Column 2, Lines 27-29).

As for Claim 8, DURST discloses further comprises providing a medium displaying of building elements, utilizing the input devices and signal indicates the selected indicium's {See Column 6, Lines 44-47, wherein this reads over “the software for the system makes the record of each “hit”, recording the date, time, item accessed and a user ID indicating who made the access, in a hit log database”}, except the plurality of damage building elements.

THOMPSON discloses the estimating cost with the plurality of building elements {See Column 3, Lines 38-40, wherein this reads over "the configuration system interacts with the system to configure and estimate the cost of a desired product, component, or project"}.

BORGHESI discloses the method of damage estimate {See Column 5, Lines 4-5, wherein this reads over "inspection is conducted to determine the extent of damage"}. It would have been obvious to combine DURST and THOMPSON teachings with the damage estimate (Element 16), as taught by BORGHESI because it would eliminate the need for separate paper files or data files and eliminate the need for the wasteful reentry of existing files (Column 2, Lines 27-29).

As for Claim 9, which has the same limitations as in Claim 4, therefore, it is rejected for the similar set forth in Claim 4.

As for Claim 10, DURST discloses, wherein comprising providing a plurality of barcodes designating commands that are executable by the portable computer, and scanning the barcode with a barcode reader to provide a signal to the portable computer indicating a command to be executed {See Column 6, Lines 44-47, wherein this reads over "the software for the system makes the record of each "hit", recording the date, time, item accessed and a user ID indicating who made the access, in a hit log database"}.

As for Claim 11, DURST discloses utilizing the input device comprises selecting an icon on a display screen of a portable computer {See Column 5, Lines 39-42,

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wherein this reads over “the linkage client prompts the user to enter configuration information and then requests permission to register”}.

As for Claim 14, THOMPSON discloses, further comprising multiplying the cost for the given building element by a quantity of the given building element to produce element cost and wherein the element cost is utilized to calculate the total cost to the building {See Column 3, Lines 38-40, wherein this reads over “the system to configure and estimate the cost of a desired product, component, or project.

As for Claim 15, DURST and THOMPSON do not teach further comprises storing information designated by the input device and wherein the output signal produced from the output device also indicates that information.

BORGHESI discloses the method of damage estimate {See Column 5, Lines 4-5, wherein this reads over “inspection is conducted to determine the extent of damage”}. It would have been obvious to combine the DURST and THOMPSON teachings with the damage estimate (Element 16), as taught by BORGHESI because it would eliminate the need for separate paper files or data files and eliminate the need for the wasteful reentry of existing files (Column 2, Lines 27-29).

As for Claim 16, DURST and THOMPSON do not teach wherein areas of the building where the given building elements are located organize the information regarding the given building elements designated by the input device.

BORGHESI discloses the method of damage estimate {See Column 5, Lines 4-5, wherein this reads over “inspection is conducted to determine the extent of damage”}. It would have been obvious to combine DURST and THOMPSONN teachings with the

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damage estimate (Element 16), as taught by BORGHESI because it would eliminate the need for separate paper files or data files and eliminate the need for the wasteful reentry of existing files (Column 2, Lines 27-29).

As for Claim 17, DURST and THOMPSON do not teach wherein rooms of the building where the given building elements are located organize the information regarding to the given building elements designated by the input device.

BORGHESI discloses the method of damage estimate {See Column 5, Lines 4-5, wherein this reads over "inspection is conducted to determine the extent of damage"}. It would have been obvious to combine the DURST and THOMPSON teachings with the damage estimate (Element 16), as taught by BORGHESI because it would eliminate the need for separate paper files or data files and eliminate the need for the wasteful reentry of existing files (Column 2, Lines 27-29). Information regarding the given building elements designated by the input device organized by rooms of the given building elements are located is merely a design choice within the skill of one of ordinary skill in the art to use the organized by rooms of the given building elements.

As for Claim 18, DURST and THOMPSON do not teach wherein the information regarding the given building elements designated by the input device is organized categories of building elements.

BORGHESI discloses the method of damage estimate {See Column 5, Lines 4-5, wherein this reads over "inspection is conducted to determine the extent of damage"}. It would have been obvious to combine the DURST and THOMPSON teachings with the damage estimate (Element 16), as taught by BORGHESI because it would eliminate the

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need for separate paper files or data files and eliminate the need for the wasteful reentry of existing files (Column 2, Lines 27-29). Information regarding the given building elements designated by the input device organized by categories of the given building elements are located is merely a design choice within the skill of one of ordinary skill in the art to use the organized by categories of the given building elements.

As for Claims 19, THOMPSON discloses, further comprising producing cost subtotals for a plurality of categories of building elements {See Column 3, Lines 38-40, wherein this reads over "the configuration system interacts with the system to configure and estimate the cost of a desired product, component, or project"}.

As for Claim 20, DURST and THOMPSON do not teach wherein providing the portable comprises assigning a record number to the cost for each of the plurality building elements, in which the record number indicates a location of the cost in the data table; and the signal from the input device designates the record number assigned to the given building elements.

BORGHESI discloses the method of damage estimate {See Column 5, Lines 4-5, wherein this reads over "inspection is conducted to determine the extent of damage"}. It would have been obvious to combine the DURST and THOMPSON teachings with THOMPSON with the damage estimate (Element 16), as taught by BORGHESI because it would eliminate the need for separate paper files or data files and eliminate the need for the wasteful reentry of existing files (Column 2, Lines 27-29). Information regarding the given building elements designated by the input device organized by

categories of the given building elements are located is merely a design choice within the skill of one of ordinary skill in the art to use the organized by categories of the given building elements.

As for Claim 21, which has the same limitations as in Claim 7, therefore, it is rejected for the similar set forth in Claim 7.

As for Claim 22, which has the same limitations as in Claims 7, 8 and 21, respectively, therefore, it is rejected for the similar set forth in Claims 7, 8 and 21, respectively.

As for Claim 23, which has the same limitations as in Claims 7-9 and 21-22, respectively, therefore, it is rejected for the similar set forth in Claims 7-9 and 21-22, respectively.

As for Claim 24, which has the same limitations as in Claims 7, 20 and 21, respectively, therefore, it is rejected for the similar set forth in Claims 7, 20 and 21, respectively.

### ***Response to Arguments***

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Claims 7-19 and

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21-24, combining the teaching of DURST ET AL., THOMPSON ET AL. and BORGHESI ET AL. would teach how to use an input device to scan indicia to designated a damaged building element to perform the job estimation.

6. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,542,933 (DURST, JR. ET AL.), U.S. Patent No. 6,810,401 (THOMPSON ET AL.), U.S. Patent No. 5,950,169 (BORGHESI ET AL.) and further in view of U.S. Patent No. 6,661,920 (SKINNER).

As for Claim 12, DURST, THOMPSON and BORGHESI do not teach wherein utilizing the input device comprises speaking into a microphone.

SKINNER discloses the input device comprises of speaking into the microphone (Element 530). It would have been obvious to combine the DURST, THOMPSON and BORGHESI teachings with the voice recognition or speaking into a microphone, as taught by SKINNER, because it is useful and allows a user to have an alternative for of character entry other than using a barcode scanner to enter a new character (Column 8, Lines 62-63).

As for Claim 13, DURST, THOMPSON and BORGHESI do not teach further comprising the portable computer executing a speech recognition program that converts the signal from the microphone into data for accessing the data table in the storage device.

SKINNER discloses the portable computer executing a speech recognition (Element 530) program that converts the signal or characters from the microphone and copied into the data queue of the application window (Column 10, Lines 11-12). It would have



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been obvious to combine the DURST, THOMPSON and BORGHESI teachings with the speech recognition (Element 530), as taught by SKINNER because it is useful and allows a user to have an alternative for of character entry other than using a barcode scanner to enter a new character (Column 8, Lines 62-63).

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

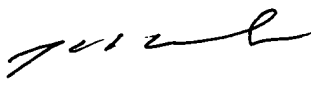
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT  
5/1/2005

  
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